

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Carsten SCHELP et al.)	Group Art Unit: 1641
)	
Application No.: 10/024,258)	Examiner: Gary W. Counts
)	
Filed: December 21, 2001)	
)	Confirmation No.: 5022
For: DETECTION METHODS)	

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPLICATION FOR PATENT TERM ADJUSTMENT—PRE-GRANT

In accordance with 37 C.F.R. § 1.705(b), Applicant hereby applies for additional patent term adjustment under 35 U.S.C. § 154(b) of 163 days. This application is being filed before or with the issue fee payment, as required by 37 C.F.R. § 1.705(b).

Attachment: Interview Summary mailed with Office Action dated February 2, 2005.

I. Statement of the Facts Involved

A. Correct Patent Term Adjustment

Applicant received the Determination of Patent Term Adjustment with the Notice of Allowance and Fee(s) Due mailed from the Patent and Trademark Office (PTO) on September 2, 2010, advising that this application is entitled to **49 days** of patent term adjustment. Applicant has calculated a patent term adjustment of **212 days** based on the following facts:

Relevant Dates

The above-identified application was filed on December 21, 2001.

A Pre-Exam Formalities Notice was mailed on March 27, 2002, and a separate miscellaneous action not on the merits (Request for Applicant Statement Regarding Potential DOE Interest) was mailed on April 29, 2002.

Applicant timely filed responses to these items on May 20 and June 7, 2002, respectively.

The first Office Action, a Restriction Requirement, was mailed on March 23, 2004, **resulting in a PTO delay of 396 days** beyond the 14 months provided by 35 U.S.C. § 154(b).

Applicant timely filed a response on April 23, 2004.

An Office Action (a second Restriction Requirement) was mailed on July 14, 2004. In a phone conversation with Applicant's representative on August 12, 2004, the Examiner informed Applicant's representative that **the restriction mailed July 14, 2004, has been vacated**, that no response is required, and that a new restriction would be issued. See the attached Interview Summary, which was mailed with the next Office Action, on February 2, 2005.

Applicant believes an error in patent term adjustment occurred due to the PTO's use of the mailing date of the vacated Office Action (July 14, 2004) instead of the mailing date of February 2, 2005. Applicant respectfully submits that when the Office vacated the July 14, 2004, Office Action, it rendered that Office Action void and inoperative and without any force or effect. Accordingly, the mailing date of July 14, 2004, is irrelevant to Patent Term Adjustment.

An Office Action (a third Restriction Requirement) was mailed on February 2, 2005, **resulting in a PTO delay of 163 days** beyond the 4 months provided by 35 U.S.C. § 154(b), as measured from Applicant's response filed April 23, 2004.

Applicant timely filed a response on May 2, 2005.

An Office Action was timely mailed on July 29, 2005.

Applicant filed a response on October 31, 2005, **resulting in Applicant delay of 2 days** beyond the 3 months to reply under 37 CFR § 1.704(b).

An Office Action was timely mailed on February 7, 2006.

Applicant filed a response on June 6, 2006, **resulting in Applicant delay of 30 days** beyond the 3 months to reply under 37 CFR § 1.704(b).

An Office Action was timely mailed on August 25, 2006.

Applicant filed a Notice of Appeal on February 23, 2007, **resulting in Applicant delay of 90 days** beyond the 3 months to reply under 37 CFR § 1.704(b). A response and Request for Continued Examination were filed on July 20, 2007.

An Office Action was mailed on November 21, 2007, **resulting in a PTO delay of 1 day** beyond the 4 months provided by 35 U.S.C. § 154(b).

Applicant filed a response on April 21, 2008, **resulting in Applicant delay of 60 days** beyond the 3 months to reply under 37 CFR § 1.704(b).

An Office Action was mailed on September 4, 2008, **resulting in a PTO delay of 14 days** beyond the 4 months provided by 35 U.S.C. § 154(b).

Applicant filed a response and Request for Continued Examination on March 4, 2009, **resulting in Applicant delay of 90 days** beyond the 3 months to reply under 37 CFR § 1.704(b).

An Office Action was timely mailed on May 27, 2009.

Applicant filed a response on October 27, 2009, **resulting in Applicant delay of 61 days** beyond the 3 months to reply under 37 CFR § 1.704(b).

An Office Action was timely mailed on January 15, 2010.

Applicant filed a response and Request for Continued Examination on May 14, 2010, **resulting in Applicant delay of 29 days** beyond the 3 months to reply under 37 CFR § 1.704(b).

A Notice of Allowance was timely mailed on September 2, 2010.

Thus, the total adjustment based on **PTO delay is 574 days**, and the reduction in term adjustment for **Applicant delay is 362 days**, resulting in a patent term adjustment of **212 days total**. Applicant respectfully requests that the current patent term adjustment be reconsidered.

B. Terminal Disclaimer

The above-identified application is not subject to a Terminal Disclaimer.

C. Reasonable Efforts

Other than those discussed above, there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing of examination of the above-identified application, as set forth in 37 C.F.R. § 1.704.

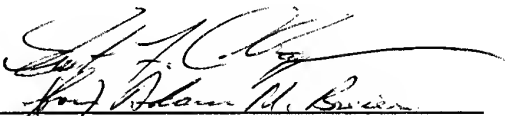
II. Fee

As required by 37 C.F.R. § 1.705(b)(1), this application is accompanied by a payment of \$200.00 to cover the required fee. Please charge any deficiencies to Deposit Account 06-0916. If there are any other fees due in connection with the filing of this request, please charge them to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: NOV 24 2010

By: 
Adam M. Breier, Ph.D.
Reg. No. 63,718
(650) 849-6650 ERNEST F. CHAPMAN
Reg. No. 25,961

Attachment: Interview Summary mailed with Office Action dated February 2, 2005.

Interview Summary	Application No. 10/024,258	Applicant(s) SCHELP ET AL.	
	Examiner Deborah A Davis	Art Unit 1641	

All participants (applicant, applicant's representative, PTO personnel):

(1) Deborah A Davis. (3)_____.

(2) Mr. Hartmann. (4)_____.

Date of Interview: 8-12-04.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.
If Yes, brief description: _____.

Claim(s) discussed: _____.

Identification of prior art discussed: _____.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Mr. Hartmann was informed that the previous restriction mailed July 14, 2004 has been vacated. No response is required. A new restriction will be issued.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner.
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.